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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,351	02/21/2001	Takayuki Usui	Q61689	1061

7590

04/28/2003

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/788,351

Applicant(s)

USUI ET AL.

Examiner

Walter B Aughenbaugh

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AS-11

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-22.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION***Acknowledgement of Applicant's Amendments***

1. The amendments made in claims 1, 2, 7 and 13 given on pages 2-4 of Applicant's Amendment (Paper # 10) have not been entered due to the fact that they raise new issues that would require further consideration and/or search. The term "planographic" that was inserted before "printing plate" in the second line of both claims 1 and 7 raises new issues because this recitation is made "not only with respect to the manner in which a claimed article is intended to be employed (i.e., not only in the preamble of the claim)" as pointed out by Applicant in a passage starting on the second-to-last line of page 8 and ending the second line of page 9 (of Paper #10), contrary to the original claims 1 and 7 (which were not amended prior to final rejection) which recited the term "planographic" only in the intended use phrase "for packaging a planographic printing plate" that was not given patentable weight as made of record in the second paragraph bridging pages 4 and 5 of Paper #4.

ANSWERS TO APPLICANTS ARGUMENTS

2. Applicant's arguments in Paper #10 regarding the 35 U.S.C. 112 rejection of claims 1 and 7 made in Paper #4 and repeated in Paper #8, have been fully considered but are not persuasive.

The claims should positively set forth the purpose of the "material for packaging" and the structure necessary for carrying out the purpose, i.e., the claim is incomplete in regard to the structure of the "material for packaging". No structure is claimed for the "material for packaging"; therefore, the scope of the claims cannot be ascertained thus rendering the claims indefinite. In response to Applicant's argument that "the claims are not indefinite; they are

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merely broad”, Examiner agrees that the broadness of a claim does not make the claim indefinite: the claims are rejected as indefinite not because of the breadth of the scope of the claims but due to the fact that structure is not assigned to the “material for packaging”. The claims are indefinite due to the fact that the scope of the claims, and not the breadth of the scope of the claims, cannot be ascertained. In response to Applicant’s argument that “when claiming chemical compositions, no shapes are specified”, claim 1 and 7 are not composition claims. Claim 1 recites “the material compris[es] opposing surfaces”, surfaces that are further limited in the remainder of the claim. The limitation that “the material compris[es] opposing surfaces” is a structural limitation, which renders claim 1 an article claim. Likewise, claim 7 recites “the material compris[es] a contact surface... and a noncontact surface opposing the contact surface”, which is a structural recitation that renders claim 7 an article claim. In response to Applicant’s argument that “the physical shape of the packaging material is irrelevant and may vary significantly in the present invention. In short, the shape of the packaging material has nothing to do with carrying out the purpose of the invention as set forth in claims 1 and 7”, claims 1 and 7 are not composition claims but are article claims, and as established above, the claims should positively set forth the purpose of the “material for packaging” and the structure necessary for carrying out the purpose, i.e., the claim is incomplete in regard to the structure of the “material for packaging”. It is the structure recited in the claim that establishes the purpose of the article, and claims 1 and 7 recite no structure for the “material for packaging”. Applicant’s citation of 2173.05(a) of the MPEP states that the claim complies with 35 U.S.C. 112, second paragraph if the scope of the invention can be reasonably apprised by those of skill in the art. The scope of patent protection intended to be outlined by claims 1 and 7 cannot be ascertained since no

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structure is provided in these claims. In fact, the scope of the “packaging” structures claimed in claims 1 and 7 (all “packaging” structures) is different from that disclosed in the specification, which is limited to a sheet structure (see, e.g., page 2, first full paragraph).

3. Applicant’s arguments in Paper #10 regarding the 35 U.S.C. 102(b) rejection of claims 1, 2, 7 and 13 as anticipated by Hayashi et al. made in Paper #4 and repeated in Paper #8, have been fully considered but are not persuasive.

In response to Applicant’s argument that Hayashi is concerned with a different problem than the problem address by Applicant, it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987). In response to Applicant’s argument that Hayashi “teaches away from the Bekk values below 5 seconds”, all of the ranges claimed by Applicant nonetheless overlap with the 5-10,000 second range taught by Hayashi.

In response to Applicant’s assertion that “Examiner asserts that Hayashi’s photothermographic sheet material is equivalent to a planographic plate”, Examiner wishes to make it clear on the record that Examiner did not assert that “Hayashi’s photothermographic sheet material is equivalent to a planographic plate”; lines 15-16 of page 5 of Paper #8 state “the photothermographic sheet material taught by Hayashi et al. is structurally equivalent to the planographic printing plate as claimed in the instant application”. The photothermographic sheet material taught by Hayashi et al. is structurally equivalent to the planographic printing plate in that both have a sheet structure. The particular type of material (planographic, photothermographic, etc.) used as the printing plate is a matter of intended use which has not

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been given patentable weight (as made of record in section 14 of Paper #8 on page 5) since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987).

In response to Applicant's argument that "the ranges as set forth in claims 1, 2, 7 and 13 are fundamentally different from Hayashi's range", the ranges set forth in claims 1, 2, 7 and 13 (either "3 to 55 seconds" or "3 to 900 seconds") nonetheless overlap with Hayashi's range and are therefore taught by Hayashi. Examiner agrees with Applicant that the ranges set forth in claims 1, 2, 7 and 13 do not constitute the majority of Hayashi's range and Examiner withdraws the mistaken statement that "the range of 250 to 900 seconds referred to in the last line of page 5, paper #6 constitutes the majority of the 5 to 10,000 range taught by Hayashi et al." made in the sentence bridging pages 5 and 6 of Paper #8; nonetheless, the range of 250 to 900 seconds is taught by Hayashi et al.

In response to Applicant's argument that the invention set forth in claims 7 and 13 provides a surprising result, Examiner repeats the paragraph bridging pages 7 and 8 of Paper #8: Applicant's assertion that "a Bekk smoothness from 3 to 100 seconds- for the surface that contacts the non-image side of the planographic sheet- is an important feature that produces unexpected results" (first full paragraph of page 8 of Paper #6 in reference to the data presented in Table 2 of the specification) in regard to the prevention of peeling of the film is not sufficiently justified, because the packaging material of Applicant does not produce unexpected results as film peeling does not occur for packaging materials of 3-100 or 250-900 seconds, results that would be expected from the teaching of Hayashi et al., as Hayashi et al. teach a

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suitable range of from 5 to 10,000 seconds. Furthermore, the values tested between 100 and 250 seconds (i.e. 140 and 190 seconds), the specification discloses that “there *may* be slight film peeling *depending* on types of planographic printing plates 10 *but degree of the peeling is not so serious to cause practical problems*” (page 19, lines 20-22 of specification). Therefore, all values from 3-900 are suitable values for use, as would be fully expected from the teachings of Hayashi et al.

In response to Applicant’s assertion that “the claims are directed to a narrow range that is overlapped by the range disclosed in Hayashi, and there is evidence of unexpected results”, the data presented in Tables 1 and 2 is not sufficient to support the assertion of the achievement of “unexpected results” in the form of “high separability from a non-imaging surface of a planographic printing plate” (last two lines of page 7 of Paper #6) or in the form of “prevent[ion of] peeling of the film with more certainty” (page 8 of Paper #6, first full paragraph).

In regard to Applicant’s argument that Hayashi “fails to disclose a value within Applicant’s claimed range” (page 7 of paper #6, third paragraph and repeated on page 11 of Paper #10) due to the teachings in the Examples where 360, 600 and 720 seconds are taught, Hayashi et al. still nonetheless teaches all the values in the range of 5 to 10,000 seconds by virtue of the fact that this range of 5 to 10,000 seconds is taught (N. B. and claimed). Applicant’s claimed ranges of 3 to 55 seconds and 3 to 100 seconds as referred to by Applicant are indeed taught by Hayashi et al. since Hayashi et al. teaches a range of 5 to 10,000 seconds.

In regard to Applicant’s argument that “Applicants have shown unexpected results for their narrow range” in regard to the high separability of the packaging material from a non-imaging surface, due to the “upper limit of 55 seconds”, factors not related to smoothness would

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affect the separability of a given “packaging material”, such as the material used as the packaging material, the thickness of the packaging material, the particular automatic plate-making machine used, the presence or absence of a “coating film” on the material (a “coating film” is claimed in claims 1, 7 and 13, but not in claim 2) and the material used as the “coating film”. The specification itself reads that “by making the interleaf sheet 14 to have Bekk smoothness between 3 seconds and 55 seconds in the present embodiment, the interleaf sheet 14 can be separated from the non-imaging surface with certainty in an automatic plate-feeding mechanism” (paragraph bridging pages 17-18). The fact that “there is no such case” that the interleaf sheet of this particular embodiment “adheres to the non-imaging surface of the planographic printing plates” for Bekk smoothness values of 11-55 seconds (page 17, first full paragraph), whereas an interleaf sheet with a Bekk smoothness value of 65 “sometimes, adheres to and is not separated from the non-imaging surface” (page 16, second full paragraph) for the material in the present embodiment is by no means absolute evidence that that *any* “packaging material” of the structure taught by Hayashi et al. with a larger Bekk smoothness value would not perform suitably in an automatic plate-feeding mechanism. The claims do not limit the scope of the invention to the parameters of the aforementioned “present embodiment”.

In regard to Applicant’s assertion that “one of ordinary skill in the art, following the teachings of Hayashi, would expect that smoothnesses well in excess of 55 seconds, or even 100 seconds, would not affect separability” (sentence bridging pages 8 and 9 of Paper #6) and that “one of ordinary skill in the art would not readily envisage Applicants’ narrow range[s]” (second full paragraph page 9 of Paper #6 and repeated in first full paragraph of Paper #10), the “upper limit” referred to is dependent on factors such as the material used as the packaging material, the

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thickness of the packaging material, the particular automatic plate-making machine used, the presence or absence of a “coating film” on the material and the material used as the “coating film” as discussed above. Hayashi teaches various types of materials used as the packaging material (col. 2, lines 39-47). Since the material is not specified in the claims of the instant application, the materials taught by Hayashi et al., by virtue of the fact that they are different materials, necessarily have “upper limits” that vary, but none of these materials have an “upper limit” greater than 10,000. The “upper limit” may be tailored via selection of the proper material (and suitable processing such as calendering treatment) taught by Hayashi et al. Applicants must claim a particular material or composition that is not taught by Hayashi et al., but that is supported by Applicant’s specification, which yields an “upper limit” of 55 seconds in order to distinguish the instant application from the teachings of Hayashi.

Therefore, sufficient support does not exist for the assertion of the achievement of “unexpected results” and therefore, Applicants have not met the requirement that “there is evidence of unexpected results” as required by MPEP 2131.03 for *consideration* that “the narrow range is not disclosed with ‘sufficient specificity’ and is insufficient to establish anticipation” as relied upon in Applicant’s argument. Consequently, Hayashi does indeed disclose every element as set forth and arranged in the claims despite Applicants’ assertion to the contrary in the second full paragraph of page 10 of Paper #10 (and in the first full paragraph of page 6 of Paper #6).

4. Applicant’s arguments in Paper #10 regarding the 35 U.S.C. 103 rejection of claims 3, 5, 11 and 17 over Hayashi et al. in view of Usui (US 6,306,254) and in further view of Patent Abstract of Japan 03036545 of Goto et al. (Paper #4) have been fully considered but are not persuasive.

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Examiner does not find Applicant's argument that "Hayashi does not meet all the requirements of independent claims 1, 2, 7 and 13" persuasive, as is discussed throughout the entire *ANSWERS TO APPLICANTS ARGUMENTS* section; therefore, a prima facie case of obviousness has indeed been established in the rejection of claims 3, 5, 11 and 17. Applicant is indeed engaging in piecemeal analysis of the references since Applicant is merely pointing out the limitations the secondary references do not teach that are indeed taught by Hayashi. The particular type of material (planographic, photothermographic, etc.) used as the printing plate is a matter of intended use which has not been given patentable weight (as made of record in section 14 of Paper #8 on page 5) since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987).

5. Applicant's arguments in Paper #10 regarding the 35 U.S.C. 103 rejection of claims 4, 6, 12 and 18 over Hayashi et al. in view of Dirx and in further view of Usui et al. (JP 8-39958) (Paper #4) have been fully considered but are not persuasive.

Examiner does not find Applicant's argument that "Hayashi does not meet all the requirements of independent claims 1, 2, 7 and 13" persuasive, as is discussed throughout the entire *ANSWERS TO APPLICANTS ARGUMENTS* section; therefore, a prima facie case of obviousness has indeed been established in the rejection of claims 4, 6, 12 and 18. Applicant is indeed engaging in piecemeal analysis of the references since Applicant is merely pointing out the limitations the secondary references do not teach that are indeed taught by Hayashi. The particular type of material (planographic, photothermographic, etc.) used as the printing plate is a

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matter of intended use which has not been given patentable weight (as made of record in section 14 of Paper #8 on page 5) since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987).


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Friday from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba
04/22/03 WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

4/23/03